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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,945	04/12/2000	Beatty Graydon	1930	5616

21834 7590 02/18/2005

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EXAMINER

SMITH, RUTH S

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,945

Applicant(s)

GRAYDON ET AL.

Examiner

Ruth S. Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley US 5,588,432 in view of Taccardi. Crowley discloses a therapy catheter with a sensing electrode and an electrically excited acoustic marker at the distal end (abstract, column 4); a therapy electrode mounted at the distal end (Fig. 1A, 15A); a drug-delivery lumen (Fig. 7 A-D, column 17, lines 43-65); inflatable balloon at the distal end (Figs. 19a-19c). Crowley does not expressly teach non-contact, floating sensor electrodes.

Taccardi US 4,649,924 teaches (abstract) endocardial mapping using **non-contact** sensor electrodes that make it possible to immediately obtain an endocardial map after a single cardiac beat and thereby determine the focus of a tachycardia promptly (column4, lines 36-49). It would have been obvious to someone of ordinary skill in the art at the time of the invention to provide the therapy catheter of Crowley with non-contact electrodes as taught by Taccardi so that it would be possible to immediately obtain an endocardial map after a single cardiac beat and thereby determine the focus of a tachycardia promptly. The mapping data obtained renders the catheter capable of creating an image.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motamedi et al. US 5,824,005 in view of Taccardi. Motamedi et al. teaches (abstract, Fig. 1, columns 1-2) a catheter for sensing myocardial electrical activity and laser ablation with a fiberoptic to deliver the laser energy for tissue ablation. Motamedi et al. does not teach a non-contact sensing electrode. Taccardi teaches (abstract) endocardial mapping using **non-contact** sensor electrodes that make it possible to immediately obtain an endocardial map after a single cardiac beat and thereby determine the focus of a tachycardia promptly (column4, lines 36-49). It would have been obvious to someone of ordinary skill in the art at the time of the invention to provide the therapy catheter of Motamedi with non-contact electrodes as taught by Taccardi so that it would be possible to immediately obtain an endocardial map after a single cardiac beat and thereby determine the focus of a tachycardia quickly to facilitate prompt therapy. The mapping data obtained renders the catheter capable of creating an image.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walinsky et al. US 4,641,649 et al. in view of Taccardi. Walinsky et al. disclose a catheter for microwave ablation; a coaxial waveguide; an antenna at the distal end for locating and guiding the catheter. Walinsky et al. does not teach a non-contact sensing electrode. Taccardi teaches (abstract) endocardial mapping using **non-contact** sensor electrodes

that make it possible to immediately obtain an endocardial map after a single cardiac beat and thereby determine the focus of a tachycardia promptly (column4, lines 36-49). It would have been obvious to someone of ordinary skill in the art at the time of the invention to provide the therapy catheter of Walinsky et al. with non-contact electrodes as taught by Taccardi so that it would be possible to immediately obtain an endocardial map after a single cardiac beat and thereby determine the focus of a tachycardia quickly to facilitate prompt therapy. The mapping data obtained renders the catheter capable of creating an image.

Response to Arguments

In response to applicant's argument that the therapy catheter is used in conjunction with a pulse generating signal generator which periodically places pulses in the heart and these pulses cooperate with the location locator electrode to determine the location of that electrode and consequently the catheter that it sits upon and this element is missing from the teachings of Taccardi and Crowley, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (703) 308-3063. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Ruth S. Smith".

Ruth S Smith
Primary Examiner
Art Unit 3737

RSS